

together involves only routine skill in the art. Howard v. Detroit Stove Works, 150 U.S. 164 (1893) and Nerwin v. Erlichman, 168 USPQ 177, 179."

However, it is respectfully submitted that converting either of the putting devices disclosed in the Smith and Hawkins, Sr. patents does not amount to forming a one piece article which has formerly been formed in two pieces and put together, as is suggested by the Examiner.

The Smith device is constructed using three separate elements. These are a conventional putter, a practice attachment, and strips of pressure sensitive tape disposed between the putter and practice attachment to secure them together. It is respectfully submitted that the construction of the Smith practice putter is not formed using two pieces, there are three pieces. Furthermore, it is respectfully submitted that the Smith practice putter cannot be formed into a single unitary structure without removing the strips of pressure sensitive tape, which is not disclosed or suggested by the Smith patent. Such a modification of the Smith device would amount to hindsight reconstruction on the part of the Examiner.

It is respectfully submitted that the Hawkins, Sr. patent discloses a putter attachment or adaptor for converting a conventional golf club to a practice club. The Hawkins, Sr. patent does not disclose or suggest anything regarding putting or a practice putter.

The Hawkins, Sr. practice attachment includes an attachment or adaptor that is secured to a golf club head by means of straps. As is the case with the Smith, the Hawkins, Sr. device is constructed using three separate elements. These are a conventional golf club (and not a putter), an attachment, and two straps attached to the attachment that wrap around the golf club head to secure the attachment thereto. Thus, it is respectfully submitted that the construction of the Hawkins, Sr. practice club is not formed using two pieces, there are three pieces.

Furthermore, it is respectfully submitted that the Hawkins, Sr. practice club cannot be formed into a single unitary structure without removing the two straps that are attached to the attachment, which is not disclosed or suggested by the Hawkins, Sr. patent. Such a modification of the Hawkins, Sr. golf club and attachment amounts to hindsight reconstruction on the part of the Examiner.

Therefore, and in view of the above, the purported holdings of the Howard v. Detroit Stove Works and Nerwin v. Erlichman cases cited by the Examiner are not on point when applied to the rejection of the present invention in view of the Smith and Hawkins, Sr. patents. It is respectfully submitted that the Examiner's rejection is based upon distortion and extension of the teachings of the Smith and Hawkins, Sr. patents in light of Applicant's own teachings. The only disclosure of a practice putter having a single, solid, unitary body is found in the present application, and cannot be derived from the teachings of the prior art references without using hindsight reconstruction.

In the Examiner's "Response to Arguments" section it is stated that "Smith 415' in view of Hawkins, Sr. 228' clearly show a practice putter where a conventional putter is converted into a practice putter. Such feature is desirable because the user does not have to carry two separate

putters, a conventional putter and a practice putter similar to the Applicant's invention. Thus, Smith in view of Hawkins, Sr. invention's clearly came up a novel idea of converting a conventional putter into a practice putter with a practice attachment, which allows a user to carry one putter and its practice attachment."

It is respectfully submitted that these statements are clearly indicative of the fact that the present invention is not similar to, nor is it obvious in view of, the teachings of the Smith and Hawkins, Sr. patents. The present invention is not a "conventional putter" that is "converted into a practice putter," as the Examiner asserts, it is a single unitary practice device that is separate and distinct from a normal putter used during a golf round.

Therefore, with specific regard to independent Claim 1, it is respectfully submitted that the Smith or Hawkins, Sr. patents, taken singly or together, do not disclose or suggest a putter head that comprises "a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface that comprises a sweet spot of the putter head and lateral portions that taper rearwardly away from the ball contact surface".

Therefore, it is respectfully submitted that Claim 1 is not obvious in view of the Smith or Hawkins, Sr. patents, taken singly or together. Accordingly, withdrawal of the Examiner's rejection and allowance of Claim 1 are respectfully requested.

With regard to independent Claim 9, and in view of the above arguments, it is respectfully submitted that the Smith or Hawkins, Sr. patents, taken singly or together, do not disclose or suggest a putter head that comprises "a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface that comprises a sweet spot of the putter head and lateral portions that taper rearwardly away from the ball contact surface".

Therefore, it is respectfully submitted that Claim 9 is not obvious in view of the Smith or Hawkins, Sr., taken singly or together. Accordingly, withdrawal of the Examiner's rejection and allowance of Claim 9 are respectfully requested.

Dependent Claims 2, 4, 5, 6, 10, 12, 13 and 14 are considered patentable over the Smith or Hawkins, Sr. patents, taken singly or together, based upon the patentability of Claims 1 and 9. Accordingly, withdrawal of the Examiner's rejection and allowance of Claims 2, 4, 5, 6, 10, 12, 13 and 14 are respectfully requested.

Claims 7 and 15 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over US Patent No. 3,489,415 issued to Smith in view of US Patent No. 5,135,228 issued to Hawkins, Sr. in view of US Patent No. 6,402,638 issued to Kelly and US Patent No. 4,121,833 issued to Prueter. The Examiner cited the Kelly and Prueter patent as disclosing a shaft inserted into the practice putter head.

It is respectfully submitted that Claims 7 and 15 are patentable over the cited patents, taken singly or together, based upon the patentability of Claims 1 and 9. Accordingly, withdrawal of the Examiner's rejection and allowance of Claims 7 and 15 are respectfully requested.

Claims 7 and 15 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over US Patent No. 3,489,415 issued to Smith in view of US Patent No. 5,135,228 issued to Hawkins, Sr. and further in view of US Design Patent No. D234,962 issued to Swash. The Examiner cited the Swash patent as disclosing a shaft inserted into the practice putter head.

It is respectfully submitted that Claims 7 and 15 are patentable over the cited patents, taken singly or together, based upon the patentability of Claims 1 and 9. Accordingly, withdrawal of the Examiner's rejection of Claims 7 and 15 is respectfully requested.

Claims 3, 8, 11 and 16 are rejected under 35 U.S.C. 103 (a) as being unpatentable over US Patent No. 3,489,415 issued to Smith in view of US Patent No. 5,135,228 issued to Hawkins, Sr. and further in view of US Patent No. 5,388,832 issued to Hsu. The Examiner cited the Hsu patent as disclosing "a shaft 10 that has an offset and is inserted into the neck 16".

It is respectfully submitted that Claims 3, 8, 11 and 16 are patentable over the cited patents, taken singly or together, based upon the patentability of Claims 1 and 9. Accordingly, withdrawal of the Examiner's rejection of Claims 3, 8, 11 and 16 is respectfully requested.

The prior art heretofore made of record and not relied upon is considered pertinent to applicant's disclosure to the extent indicated by the Examiner.

In view of the above, it is respectfully submitted that Claims 1-16 are not anticipated by, nor are they obvious in view of, the cited patents, taken singly or together, and are therefore patentable. Accordingly, it is respectfully submitted that the present application is in condition for allowance. Reconsideration and allowance of this application are earnestly solicited. It is again respectfully submitted that the present response does not require further searching by the Examiner, and places this application in condition for allowance, or in any event, places it in better condition for consideration on appeal.

Respectfully submitted,



Kenneth W. Float  
Registration No. 29,233

The Law Offices of Kenneth W. Float  
Office Address: 2 Shire, Coto de Caza, CA 92679  
Mailing Address: P. O. Box 80790, Rancho Santa Margarita, CA 92688  
Telephone: (949) 459-5519  
Facsimile: (949) 459-5520